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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,288	10/15/2003	José Barbosa Machado Neto	J92-055US	7119

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NOTARO AND MICHALOS
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SUITE 110
ORANGEBURG, NY 10962-2100

EXAMINER

HEINRICH, SAMUEL M

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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01/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,288

Applicant(s)

NETO, JOSE BARBOSA
MACHADO

Examiner

Samuel M. Heinrich

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 30-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for marking or engraving means aiming to "engrave in high or low relief", does not reasonably provide enablement for a laser applying device "selectively applicable in low and high relief". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to utilize the invention commensurate in scope with these claims. The new limitation provides on-the-fly selection of high relief and low relief laser application.

Claims 30-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for markings "having at least one of logotype, product origin, and expiration date", does not reasonably provide enablement for markings "having all of logotype, product origin, and expiration date". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to utilize the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-34 are rejected under 35 U.S.C. 103(a) as obvious over USPN 5,897,797 to Drouillard et al in view of USPN 5,932,119 to Kaplan et al for the same reasons as set forth in the last Office action.

Drouillard et al describes laser marking. Drouillard et al describe marking produce and patent citation 4,839,181 listed on the front page of Drouillard et al describes use of a laser with a meat product. Drouillard et al describe (column 10, lines 25-39) use of sensors to determine the size of the workpiece and how far the laser should be from the workpiece. Drouillard et al describe (column 6, line 65 through column 7) laser 28 "is connected to and controlled by a suitable computer 44, see FIG. 6" which computer "is appropriately pre-programmed to send the correct signals to the laser 28 depending on the size and type of the produce 24 being marked."

Kaplan et al describe laser marking systems with selectable beam intensity, sensing means, and program control. Kaplan et al describe (column 17, lines 61+) "characteristics of the workpiece may be determined by eye 146, and may also be determined by a sensor 147 of appropriate type", and describe use of "dimensions, weight, optical transmission characteristics, facet angles, and the like may be measured" for determining characteristics of the workpiece.

The use of a workpiece sensor in Drouillard et al, sensing based on workpiece type, texture, or weight, would have been obvious at the time applicant's invention was

made to a person having ordinary skill in the art because it automates old manual sensing and measuring of workpiece data.

The intended use with a particular workpiece, such as a particular meat, does not impart patentability to the apparatus claims.

The intended use with laser application of particular mark features of logotype, product origin, and expiration date does not impart patentability to the apparatus claims.

Response to Arguments

Applicant's arguments filed November 20, 2007 have been fully considered but they are not persuasive.

Applicant argues Examiner has failed to show how each of the claimed elements is found within the scope and content of analogous prior art references. This argument is not convincing. Applicant has relied on method limitations in apparatus claims in order to provide structure. Examiner has described prior art laser, monitoring sensor, and programmable logic controller in the applied prior art.

Applicant argues Examiner has failed to provide adequate rationale for combining the references. This argument is not convincing. Both Drouillard et al and Kaplan et al pertain to laser marking systems and both describe workpiece sensing and subsequent control of the laser.

Applicant argues Examiner has failed to show how one ordinarily skilled in the art would have recognized the combination without hindsight. This argument is not convincing. Both references pertain to marking and both are classified in laser 219 etching and trimming subclass 121.68.

Applicant argues Examiner has failed to consider the claimed invention and cited references as a whole. This argument is not convincing. Both the claimed invention and the Drouillard et al and Kaplan et al references are drawn to laser marking.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

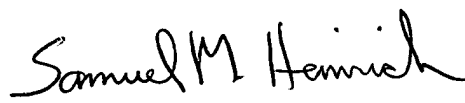
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M. Heinrich whose telephone number is 571-272-1175. The examiner can normally be reached on M-F.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Samuel M Heinrich
Primary Examiner
Art Unit 1725

SMH